

ESTTA Tracking number: **ESTTA731005**

Filing date: **03/02/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92063027
Party	Defendant Justice Beverages LLC
Correspondence Address	JUSTICE BEVERAGES LLC 3016 WAVERLY DR , SUITE 105 LOS ANGELES, CA 90039 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Steve Lory
Filer's e-mail	stevel77@juno.com
Signature	/Steve Lory/
Date	03/02/2016
Attachments	ANSWER 0 DESIGN TRADEMARK COMPLAINT 3-2-16.pdf(2110390 bytes )

Registration Subject to the filing

Registration No	3713775	Registration date	11/24/2009
Registrant	VINOLIO EXPORTS AND IMPORTS, LLC 1000 Main Street, Suite 200 NAPA, CA 94559 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 033. First Use: 2007/09/04 First Use In Commerce: 2007/09/04 All goods and services in the class are requested, namely: Wine
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I hereby certify that this correspondence is being electronically filed with the Trademark Trial and Appeal Board through the ESTTA system.

By: Meg Razi  
Meg Razi

VINOLIO EXPORTS AND IMPORTS, LLC.

Petitioner,

v.

JUSTICE BEVERAGES, LLC.

Registrant.

## ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM TO PETITION FOR CANCELLATION

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1 11. Such use of the Registrant's Trademark has been open, notorious and known to  
2 Petitioner. During this time Petitioner failed to take meaningful action to assert the  
3 claims on which it bases this Petition, on which inaction Registrant has relied to their  
4 detriment.

5 12. Petitioner failed to bring this action for over two years from the date of  
6 Registrant's application and nearly one and one-half years from the publication of  
7 such Trademark by the USPTO. Petitioner's claims are consequently barred by the  
8 doctrines of laches, acquiescence and estoppel.

9 Fourth Affirmative Defense

10 Unclean Hands/ Bad Faith

11 13. Petitioner requests cancellation of Registrant's Trademark on the false assertion  
12 that they believe there is confusion in the market place between the subject  
13 Trademarks. Petitioner in truth and fact knows that there is no confusion in the  
14 marketplace from the two subject Trademarks.

15 14. The instant cancellation action is the direct result of Petitioner wanting to move  
16 outside the wine business and into the spirits business. Petitioner had applied for  
17 two new Trademarks on October 2, 2014 "Extreme Justice" and "Justice 6.0". The  
18 applications (#86413595 and #86413599) were suspended by the USPTO due to  
19 likelihood of confusion with Registrant's Trademark.

20 15. On January 29, 2016 Petitioner represented that they have filed cancellation  
21 actions against Registrant as a direct response to the office action they received for  
22 their new Trademark Applications.

23 16. Petitioner's act in bad Faith by bringing the instant action asserting current  
24 "confusion in the marketplace" as the basis for their cancellation action when in truth  
25 and fact they know that no such confusion exists. The action of Petitioner should be  
26 dismissed due to Petitioner's Bad Faith/Unclean Hands and their tacit admission  
27 herein that the instant action is brought without basis as alleged.

1 Fifth Affirmative Defense

2 Estoppel

3 17. Petitioner has knowingly allowed the Trademarks “ Rough Justice” (for wine),  
4 “Chief Justice” (for wine) and “Justus Beer” (for Beer) to coexist in the market  
5 alongside their own Trademark. Additionally, the Mark “Sweet Justice” (for wine  
6 although not registered) is a currently being used in the wine market.

7 18. Petitioner overtly agrees to allow other Marks with the word “Justice” to  
8 peacefully coexist in the wine market knowing that due to the generic nature of the  
9 word “Justice” consumers are not confused as to source of such goods.

10 19. Based on the equitable doctrine of estoppel, Petitioner is barred from taking the  
11 contradictory position as is alleged in the instant matter.

12  
13 Sixth Affirmative Defense

14 20. Petitioner has never used the Trademark “Justice” and is therefore not entitled to  
15 use the Trademark “Justice” and therefore no confusion can exist as alleged.

16 Seventh Affirmative Defense

17 21. Likelihood of confusion does not exist because the respective good of the parties,  
18 ( Registrant’s very low priced Vodka and Petitioner’s extremely high priced wine),  
19 do not travel in the same channels of trade.

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21 **COUNTERCLAIM FOR CANCELLATION**  
22 **OF PETITIONER’S TRADEMARK**

23 Justice Beverages, LLC (“Petitioner”) hereby petitions to cancel U.S. Trademark  
24 Registration No. 3713775 (for the Trademark “JUSTICE”) on the following grounds:

25 22. Justice Beverages, LLC ( Petitioner) is a California Limited Liability  
26 Corporation having a place of business at 2000 Riverside Dr. Suite 306, Los  
27 Angeles, CA 90039.

28 23. According to the records of the USPTO, the current owner of U.S. Trademark

1 Registration No. 3713775 is VINOLIO EXPORTS AND IMPORTS, LLC. ( “  
2 Registrant”) a Corporation organized under the laws of Delaware, with a business  
3 address at 1040 Main Street, Suite 300, Napa, California 94559.

4 24. Petitioner is engaged in the field of marketing and promoting the “JUSTICE  
5 VODKA” brand ( Registration Number 4,700,836) and has an interest in maintaining  
6 the integrity of that brand.

7 25. On information and belief, and based on the specimens provided to the United  
8 State Patent Trademark Office on August 14, 2008 and June 16, 2015 by Registrant,  
9 Registrant has never used the JUSTICE Trademark in connection with the goods  
10 identified in U.S. Trademark Registration No. 3713775 and intends not to use such  
11 Trademark.

12 26. On information and belief, and based on the specimens provided to the United  
13 State Patent Trademark Office on August 14, 2008 and June 16, 2015, Registrant  
14 has not used the “JUSTICE” Trademark in connection with the goods identified in  
15 U.S. Trademark Registration No. 3713775 for at least three years and intends not to  
16 resume such use.

17 27. Registrant has only used the Trademarks “ Justice is Served”, “Poetic Justice”,  
18 “Frontier Justice”, and “Blind Justice” as its Mark for Wine products. Each of the  
19 foregoing Trademarks are Registered with the USPTO. Registrant has never used  
20 the Trademark “ Justice”.

21 28. As a result of its non-use of the JUSTICE Trademark in connection with the  
22 goods identified in U.S. Trademark Registration No. 3713775 with an intention not  
23 to resume use, Registrant has abandoned the JUSTICE Trademark with respect to  
24 those goods within the meaning of 15 U.S.C. § 1064(3).

25  
26 29. As a result of Registrant never using the JUSTICE Trademark in connection  
27 with the goods identified in U.S. Trademark Registration No. 3713775 , Registrant  
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1 has falsely stated a first date use and continued date of use to the United State Patent  
2 Trademark Office causing the Trademark to cancel under 15 U.S.C. § 1064(3).  
3 30. The United State Patent Trademark Office relied upon the false statements of  
4 Registrant and misleading specimens in allowing the registration and continued  
5 registration of Petitioner's Trademark. Such registration would not have been  
6 allowed had it been known to the United State Patent Trademark Office that such  
7 false statements and specimens had been submitted to obtain such registration of said  
8 Trademark.

9 WHEREFORE, Petitioner prays that the Trademark Trial and Appeal Board:

- 10 1. DENY the Petition of Vinolio Exports and Imports, LLC for Cancellation  
11 of Justice Beverages LLC Trademark Number 4,700,836.
- 12 2. GRANT Justice Beverages, LLC.'s Petition to Cancel U.S. Trademark  
13 Registration No. 3713775 of Vinolio Exports and Imports, LLC based on a)  
14 the abandonment of such Trademark and b) the falsity of the data submitted in  
15 support of such original Trademark application.
- 16 3. Allow Justice Beverages, LLC. Costs and Fees to the extent allowable under  
17 law against Vinolio Exports and Imports, LLC.

22 DATED: March 2, 2016

21 By: 

Steve Lory  
Attorney At Law  
3016 Waverly Drive, Ste 105  
Los Angeles, California 90039  
310 409-9309

Attorneys for Registrant  
JUSTICE BEVERAGES, LLC.

1 **PROOF OF SERVICE**

2 I declare that I am over the age of 18 years, employed in the County of LOS ANGELES, and not a  
3 party to the within action; my business address is 2000 Riverside Drive, Los Angeles, California  
4 90039.

5 On March 2, 2016, I placed a copy of the following document(s):

6  
7 ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM TO PETITION  
8 FOR CANCELLATION

8 Re: CANCELLATION NO: 92063027

9 in a sealed envelope addressed as shown below and placing the envelope for collection and  
10 mailing following our ordinary business practices. I am readily familiar with this business'  
11 practice for collecting and processing correspondence for mailing. On the same day that  
12 correspondence is placed for collection and mailing, it is deposited in the ordinary course of  
13 business with the United States Postal Service in a sealed envelope with postage fully prepaid.

14 The persons served are as follows:

15 J. Scott Gerien; Christopher Passarelli  
16 Dickenson Peatman & Fogarty  
17 1455 First St., Ste. 301  
18 Napa, CA 94559

19  
20 I declare under penalty of perjury under the laws of the State of California that the  
21 foregoing is true and correct.

22 Executed March 2, 2016, at San Diego, California.

23  
24 By: \_\_\_\_\_

*Mary Razi*